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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Per A. Tagseth

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FITZPATRICK CELLA (AMEX)
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

AHMED, AFFAF

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

07/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/091,612	TAGSETH ET AL.	
	Examiner	Art Unit	
	AFAF AHMED	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,9-36 and 38-50 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,9-36 and 38-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17 (e), was filed in this application after final rejection. since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17 (e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/30/2009 has been entered.
2. Claims 1, 38, 42, 44, 48 and 50 have been amended.
3. Claims 6-8, 37 have been canceled.
4. Claims 1-5, 9-36, 38-50 are currently pending and have been examined.

Response to Applicant's Arguments

5. Applicant's amendment and arguments filed on 04/30/2009 have been fully considered and discussed in the next section.
6. Applicant's arguments with regard to claim objection for informalities of claims 49 and 50 are considered, and the objection is withdrawn.
7. Applicant's arguments and amendment with regard to claims 42, 44, 48 and 50 rejection under 35 USC § 112, first paragraph are considered and the rejection of 112 first paragraph is withdrawn,
8. Applicant's arguments and amendment with regard to claims 42, 44, 48 and 50 rejection under 35 USC § 112 second paragraph are considered and the rejection of 112 second paragraph is withdrawn,
9. with regard to claims 1 and 36:
10. Applicant's arguments with regard to "modifying elements within an advertisement after selection" are considered, but they are moot based on new ground (s) of rejection.
11. Applicant's arguments with regard to "a system for administering incentives offers that includes the limitations of the claims" are considered. However, the recitation of "*a system for administering incentives offers*" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1-5, 9-36 are rejected under 35 U.S.C. 101 because the limitations recite a system per se which may be equated to that of interconnected devices which is defined by its physical structural elements and corresponding functionality. No physical structural elements are recited; the claims are directed to non statutory subject matter. The body of the claims comprise software, which are virtual not physical structures.

14. Claims 38-50 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

15. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

16. Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1, 2, 5, 9, 11-22, 34, 38, 43-44 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over McElfresh et al, US Pat 6,907,566 B1 in view of Dedrick, US Pat No: 5,696,965.

Claims 1 and 38:

McElfresh discloses:

- *a centralized repository configured to store a plurality of incentive offers (see at least column 6, lines 57-65);*

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- *a retrieval engine communicatively coupled to the centralized repository for retrieving one or more incentive offers from the plurality of incentive offers (see at least column 7, lines 5-14 and fig 3 A with the associated text);*
- *a presentation engine communicatively coupled to retrieval engine for presenting the one or more incentive offers, to an offeree (see at least column 6, lines 36-40 and fig 3A with the associated text);*
- *wherein the retrieval engine is configured to retrieve the one or more offers based at least in part on a set of rules defining particular contexts required to present the plurality of incentives offers stored in the central repository to specific offerees (see at least column 6, lines 15-56, column 7, lines 8-13 and column 2, lines 56-62);*

McElfresh does not specifically disclose, but Dedrick however discloses:

- *wherein the presentation engine is configured to receive the one or more retrieved offers from the retrieval engine and then after selection by the retrieval engine modify at least one element of at least one retrieved offer based on an offeree's trait and a context in which the one or more retrieved offers are to be presented (see at least column 5, lines 1-13, column 8, lines 40-56 and fig 2 with the associated text);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine McElfresh's teaching of optimizing advertisements (offers) on a webpage with Dedrick's teaching of selecting and then modifying advertisement (offers) based on user's information (offeree's traits) with the motivation of providing users personalized advertisements (offers).

Claim 2:

McElfresh/ Dedrick disclose the limitations as shown above.

McElfresh further discloses:

- *a maintenance engine being adapted to cooperate with an administrator to create, modify, or delete an offer stored within the centralized repository (see at least column 7, lines 1-13);*

Claim 9:

McElfresh/ Dedrick disclose the limitations as shown above.

McElfresh further discloses:

- *maintenance engine being configured to facilitate tracking of times a particular offer has been sought or retrieved* (see at least column 11, lines 10-14);

Claim 11:

McElfresh/ Dedrick disclose the limitation as shown above.

McElfresh does not specifically disclose:

- *maintenance engine being configured to facilitate export of a report in accordance with a predetermined set of criteria* (see at least column 7, lines 33-60 and fig 3A with the associated text, and column 8, lines 15-28);

Claim 12:

McElfresh/ Dedrick disclose the limitations as shown above.

McElfresh further discloses:

- *retrieval engine being configured to facilitate presenting of offers via a webpage* (see at least column 7, lines 12-14);

Claims 13-20:

McElfresh/ Dedrick disclose the limitations as shown above.

McElfresh further discloses:

- *a retrieval engine including a search tool for retrieving offers based on search criteria specified by a user;*
- *retrieval tool being configured to facilitate retrieval of an offer, said offer including only parameters defined by a user;*

See at least column 2, lines 44-48, column 7, lines 8-14, column 9, lines 7-21 and fig 3A and fig 3B with the associated text;

Claims 21 and 22:

McElfresh/ Dedrick disclose the limitations as shown above.

McElfresh does not specifically disclose:

- *retrieval engine is configured to facilitate generation of a report describing offers contained within the repository;*
- *retrieval engine is configured to facilitate generation of a report describing times an offer has been retrieved;*

See at least column 6, lines 57-67 and fig 3A with the associated text, column 7, lines 33-60 and fig 3A with the associated text and column 8, lines 15-28;

Claim 23:

McElfresh/ Dedrick disclose the limitations as shown above.

McElfresh further discloses:

- *retrieval engine being configured to facilitate modification of an offer in accordance with a predetermined set of rules (see at least column 7, lines 8-14);*

Claim 34:

McElfresh/ Dedrick disclose the limitations as shown above.

McElfresh further discloses:

- *wherein the centralized repository is further configured to store a set of offer details and the set of offer details include at least key word(s) (see at least column 6, lines 57-67 and fig 3A with the associated text);*

19. Claims 3, 4, 24-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over McElfresh et al, US Pat 6,907,566 B1 in view of Sullivan et al, US. Pub. No. 2001/0018665 A1.

Claims 3 and 4:

McElfresh/ Dedrick disclose the limitation as shown above.

McElfresh does not specifically disclose, however Sullivan discloses:

- *provide a security mechanism to authenticate a merchant before granting access to the merchant;*
- *security mechanism being configured to limit access to a specific merchant or group of merchants whereby the security mechanism enables the maintenance engine to safeguard the confidentiality of data within the repository, preventing data from being disclosed in an unauthorized or undesirable manner (see at least paragraphs 106 and 107);*

It would have been obvious to one of ordinary skills in the art at the time of the invention to combine McElfresh's technique for presenting optimum advertisements on a webpage with Sullivan's technique of providing security mechanism of authentication to the system with the motivation to prevent malicious attack of the system.

Claim 24:

McElfresh/ Dedrick disclose the limitation as shown above.

McElfresh does not disclose, but Sullivan however, does disclose:

- *offer details includes at least an offer identifier, a description of qualifying offerees and an offer promotion identifier, an offer type, and a definition of offer terms* (see at least paragraph 3, and paragraph 19);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine McElfresh's technique of creating and storing advertisements information in a database and being able to retrieve the ads information based on users requests with Sullivan's method of identifying offers, identifying promotion offers description of qualifying offerees and so forth because as shown by Sullivan above identifications of offer and promotions and qualifications of services provider are all important entities of administrating promotions to effectively track promoted products and measure the effectiveness of the promotion.

Claims 25, 27, 29, 30 and 36:

McElfresh/ Dedrick disclose the limitation as shown above.

McElfresh does not specifically disclose, but Sullivan however, discloses:

- *offer details includes at least a merchant name;*
- *said offer details includes at least merchant demographics;*
- *offer details includes at least a merchant type identifier;*
- *offer details includes at least a geographic location identifier; and*
- *offer details includes at least customer service telephone number.*

See at least paragraph 60.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine McElfresh's technique of creating and storing advertisements information in a database and being able to retrieve the ads information based on users requests with Sullivan's offer details, because as shown by Sullivan above keeping track of retailers/clients helps manufacturers /services providers to better understand consumers needs.

Claims 26 and 28:

McElfresh/ Dedrick disclose the limitation as shown above.

McElfresh does not specifically disclose, but Sullivan however, discloses:

- *offer details includes at least a trademark identifying the target merchant or the target goods;*
- *offer details includes at least an offer category identifier.*

See at least paragraph 78.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to combine McElfresh's technique of creating, storing and retrieving advertisements information based on users requests with Sullivan's terminology of offer details, because by administrating promotions, service providers know and learn which and what products are best to promote and keeping track of promoted products helps manufacturers /services to improve their services, manage and expand their marketing plans to better understand and target consumers in future.

Claims 31, 32 and 33:

McElfresh/ Dedrick disclose the limitation as shown above.

McElfresh does not specifically disclose, but Sullivan however, discloses:

- *offer details includes at least a target product or service identifier ;*
- *offer details includes at least a description of a term of the offer ;*
- *offer details includes at least a definition of the term length for displaying the offer*

;

See at least paragraphs 13 and 108.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine McElfresh's technique of creating, storing and retrieving advertisements information based on users requests with Sullivan's terminology of offer details, because as shown above by Sullivan above keeping track of promoted products helps manufacturers/services to improve their services and meet consumers needs in a competent manner.

Claim 35:

McElfresh/ Dedrick disclose the limitation as shown above.

McElfresh does not specifically disclose, but Sullivan however, discloses:

- *offer details includes SKU/UPC information (see at least paragraph 14);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine McElfresh's technique of creating and storing advertisements information in a database with Sullivan's terminology of offer details, because as shown by Sullivan above keeping track of promoted products helps manufacturers /services to improve their services and meet consumers needs in a competent manner.

20. Claims 42 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over McElfresh et al, US Pat 6,907,566 B1 in view of Walker et al, US Pat No: 6,598,024.

Claims 42 and 48:

McElfresh/ Dedrick disclose the limitation as shown above.

McElfresh does not specifically disclose, but Walker however discloses:

- *wherein the context includes the availability of a product* (see at least column 5, lines 61-67 and column 6, lines 1-4);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the well known elements of McElfresh for the optimization of ads (offers) over the internet with the well known element of Walker's method and system of offering products based on the availability of the product and the context of the offer, since in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

21. Claims 5, 43-44 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over McElfresh et al, US Pat 6,907,566 B1.

Claim 5:

McElfresh/ Dedrick disclose the limitation as shown above.

McElfresh does not specifically disclose:

- *wherein the system comprises one or more reviewing interfaces configured to allow reviewers to review and approve new offers;*

However, Official Notice is taken that it is old and well known in advertising art that when creating and licensing advertisement there are numerous review and approval cycles.

For example, when a manufacturer proposes a promotion to a retail store. The manufacturer representative offers a promotion to a retailer buyer by providing the buyer the nature and terms (contract) of the promotion. The retailer buyers evaluates the proposed promotion and analyses it in terms of the retailer needs (business objectives of the promotion, timing of the promotion, financial impact of the promotion, etc). After evaluating the proposed promotion, the retailer accepts the promotion as is, or negotiates different terms or rejects the promotion.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify McElfresh's/ Dedrick's teaching of optimizing and modifying advertisements (offers) on a webpage to include reviewing interface that allows review and approval of new offers with the motivation of ensuring the promotion is accurate, effective and conducted in compliance with the agreed terms.

Claims 43-44 and 49-50:

McElfresh/ Dedrick disclose the limitation as shown above.

McElfresh does not specifically disclose:

- *wherein the offer element modified is the price of a product;*
- *wherein the price is modified based on the contextual environment criteria and wherein the contextual environment criteria includes a quantity of the product;*

However, Official Notice is taken that it old and well known in marketing art, that a price of a product is modified based on the availability (i.e. quantity) and the contextual environment of the product. For example, when a brand new Nintendo game is available for purchase, the price of the game stays high for a period of time until the company achieves their desired revenue and the product become widely available to consumers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify McElfresh's/ Dedrick's teaching of optimizing and modifying advertisements (offers) on a webpage to include modifying the price of a product based on the availability (i.e. quantity) of the product and the contextual environment of the product with the motivation of maximizing the price of the product during the introductory period for recapturing developed cost.

22. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over McElfresh et al, US Pat 6,907,566 B1 in view of Dedrick, US Pat No: 5,696,965 in view of Brody et al, US Pub No: 2002/0077964 A1.

Claim 10:

McElfresh/ Dedrick disclose the limitation as shown above.

The combination McElfresh/ Dedrick does not specifically disclose, but Borody however discloses:

- *maintenance engine being configured to facilitate tracking of times a particular class of offers has been sought or retrieved;*

See at least paragraphs 44, 41 and 69.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine McElfresh's/ Dedrick's teaching of optimizing and modifying advertisements (offers) on a webpage with Brody's teaching of providing pre-approved offers with the motivation of keeping track of specific category of offers.

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23. Claims 39-41 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over McElfresh et al, US Pat 6,907,566 B1 in view of Walker et al, US Pat 6,018,718.

Claims 39-41 and 45-47:

McElfresh/ Dedrick disclose the limitation as shown above.

McElfresh does not specifically disclose, but Walker, however discloses:

- *wherein the at least one offer element modified includes an interest rate* (see at least column 8, lines 61-67 and column 9, lines 1-35 and column 12, lines 56-57);
- *wherein the interest rate is adjusted based on at least the offeree's creditworthiness level* (see at least column 7, lines 51-60 and fig 4 with associated texts);
- *wherein the modified offer is a credit card offer* (see at least 3, lines 35-42);

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate McElfresh's technique for presenting optimum advertisements on a webpage with Walker's method of customizing rewards based on specific account criteria with the motivation of capturing consumer's attention by providing consumers with offers that best fit their characteristics and need.

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

/Yehdega Retta/

Primary Examiner, Art Unit 3622